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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/960,526	09/24/2001	Michael P. Spratt	1509-221	5271

7590 10/03/2005

HEWLETT-PACKARD COMPANY
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EXAMINER	
RHODE JR, ROBERT E	

ART UNIT	PAPER NUMBER
3625	

DATE MAILED: 10/03/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/960,526	SPRATT, MICHAEL P.	
	Examiner	Art Unit	
	Rob Rhode	3625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *25 July 2005*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-29* is/are pending in the application.

4a) Of the above claim(s) *1 – 14, 16, 18, 19, 21 and 23 - 29* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *15, 17, 20, 22* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *24 September 2001* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Response to Amendment

Claims 1 – 14, 16, 18, 19, 21 and 23 - 29 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on 7-28-05. The Applicant traversed the restriction based on the statement that this would not be burden, even thought they include claims to separate and distinct inventions. In that regard, the MPEP 802.01 also stated that "meaning of "Independent" and "Distinct" 35 U.S.C. 121 quoted in the preceding section states that the Commissioner may require restriction if two or more "independent and distinct" inventions are claimed in one application. In 37 CFR 1.141, the statement is made that two or more "independent and distinct inventions" may not be claimed in one application. With regard to the series burden of searching In Business Methods, the searching is not confined to just a single Class/subclass and in this case a different device can be used to affect the Method. Therefore, a broad text search is required across all class/subclass, which would significantly increase the burden for the Examination and therefore the Examiner.

The requirement is still deemed proper and is therefore made FINAL

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 15, 17 and 20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In Claim 17, the word "arrangement " is a relative word, which renders the claims indefinite. The word " arrangement " is not defined by the claim(s), the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably appraised of the scope of the invention. For example as depicted in Figure 6, the arrangement appears to apply to different and separate devices such as PC and PDA. For examination purposes the word "arrangement" will be treated as a providing a device with the capability for "detecting" a users selection.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 15, 17 and 20 are rejected under 35 U.S.C. 102(e) as being anticipated by Marks (US 2002/0032019 A1).

Regarding claim 15, Marks teaches a mobile device comprising: a communications interface for downloading categorized content items; a content handling subsystem for storing and playing downloaded content items to a user; and a usage monitor for deriving usage data concerning use of the downloaded content items, the monitor comprising a first arrangement for detecting positive usage events indicative of a user's preference for a particular content item, and a second arrangement for detecting negative usage events indicative of a user's dislike of a particular content item (see at least Abstract, Para 0009, 0024, 0043, 0082, 0092, 0110 and Figure 1).

Regarding claim 17, Marks teaches device according, wherein the first arrangement comprises means for detecting the selection for use of a particular content item (Para 0092).

Regarding claim 20, Marks teaches a device, wherein the second arrangement comprises means for detecting (Para 0009).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claim 22 is rejected under 35 U.S.C. 103(a) as being unpatentable over Marks (US 2002/0032019) in view of Herz (US 6,020,883).

Marks substantially discloses and teaches the Applicant's invention.

While Marks does disclose a mobile device and uploading, the reference does not specifically disclose a device, wherein the communication interface is arranged to upload usage data from the monitor whereby to enable a remote apparatus to derive a user preference profile for use in selecting item for download to the device.

On the other hand and regarding claim 22, Herz, in the same area of monitoring of content usage, teaches a device, wherein the communication interface is arranged to upload usage data from the monitor whereby to enable a remote apparatus to derive a user preference profile for use in selecting item for download to the device (see at least Col 42, lines 32 – 36).

It would have been obvious to one of ordinary skill in the art to have provided the device of Marks with the device of Herz to have enabled a device, wherein the communication

interface is arranged to upload usage data from the monitor whereby to enable a remote apparatus to derive a user preference profile for use in selecting item for download to the device. Marks discloses the limitations of recited claim 1. In turn, Herz discloses a device, wherein the communication interface is arranged to upload usage data from the monitor whereby to enable a remote apparatus to derive a user preference profile for use in selecting item for download to the device. Therefore, one of ordinary skill in the art would have been motivated to extend the device of Marks with device wherein the communication interface is arranged to upload usage data from the monitor whereby to enable a remote apparatus to derive a user preference profile for use in selecting item for download to the device. In this manner, the device can update the user profile in order to ensure more appropriate and preferred content.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Rob Rhode** whose telephone number is **571.272.6761**. The examiner can normally be reached Monday thru Friday 8:00 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **Wynn Coggins** can be reached on **571.272.7159**.

Any response to this action should be mailed to:

Commissioner for Patents

P.O. Box 1450

Alexandria, Va. 22313-1450

or faxed to:

571-273-8300 [Official communications; including After Final communications labeled "Box AF"]

For general questions the receptionist can be reached at 571.272.3600

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). RER

Jeffrey A. Smith
Primary Examiner